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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,767	04/11/2001	G. Mark McGregor	P00471-US-1 (17359.0003)	3380
26884	7590	09/22/2004	EXAMINER	
PAUL W. MARTIN LAW DEPARTMENT, WHQ-4 1700 S. PATTERSON BLVD. DAYTON, OH 45479-0001			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,767

Applicant(s)

MCGREGOR ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6-25-01 & 8-9-01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - A. Claims 1-13, drawn to system, classified in class 709, subclass 206.
 - B. Claims 14-20, drawn to method, classified in class 705, subclass 14.
2. The inventions are distinct, each from the other because of the following reasons: Inventions B and A are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In this case the apparatus/system can be used for general client-server communication with appendages to e-mail, for example.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or patentability requirements, restriction for examination purposes as indicated is proper.
4. In a voice mail message left by Paul W. Martin, Esq., on 10 September 2004, a provisional election was made without traverse to prosecute invention B, claims 14-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a "process" nor a "machine", but rather embrace or overlap two different statutory classes of invention (MPEP § 2173.05(p)II).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single claim that claims both an apparatus (system) and the method steps of using the apparatus is indefinite (MPEP § 2173.05(p)II).

At the 4th line from the end of each claim 14 and 18, "on second client computer the advertisement software" is indefinite.

Warning

10. Applicant is advised that should claim 14 and 15 be found allowable, claims 18-19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In this case, the two sets of claims differ only in their dependency respectively on system claims 1 and 9. System claim 9 adds only nonfunctional descriptive material to system claim 1. See MPEP 2106.IV.B.1(b), first paragraph and para. 12 below.

Claim Objection

11. Claim 20 is *provisionally* objected to under 37 CFR 1.75 as being a substantial duplicate of claim 16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). While claim 16 has not yet been allowed, the examiner has indicated below that it contains allowable matter.
12. In this case, the two claims differ only in their dependency respectively on system claims 1 and 9. Claim 9 adds to claim 1 the limitation that the information about the email user comprises the identity of a charitable organization designated to receive charitable contributions from operation of the system. This limitation is nonfunctional descriptive material that does not exhibit any functional interrelationship with the way in which the computing process is performed. (See MPEP 2106.IV.B.1(b), first paragraph.)

Claim Rejections - 35 USC § 102 and 35 USC § 103

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3622

15. Claims 14, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Rubstein et al.
16. Rubstein et al. teaches (independent claim 14) providing a system according to claim 1, transmitting an e-mail message from the first (purchaser's) client computer (*client device 12*, para. [0037]) to the *Greeting-cards.com* host server **10** (para. 0010)); appending a personalized greeting *card file 46*, containing advertising (para. [0011 and 0039]), which reads on advertisement retrieval software, to the email message, and delivering the personalized greeting *card file 46* to the recipient as an attachment to the email message (para. [0038]), which reads on transmitting the email message to the second client computer; and displaying the email message and retrieving the personalized greeting *card file 46*/advertisement retrieval software.
17. Interpretation of email Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
18. The examiner could not find in the specification any such clear definition for the phrase "e-mail". In the instant case, the examiner is required to give the term its broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be the definition given in the Microsoft Press Computer Dictionary: the exchange of text messages and computer files over a communications network. Furthermore, the communication used by a purchaser to order, personalize and send the personalized greeting *card file 46*/advertisement retrieval software is judged to be one e-mail message, and therefore reads on the instant claims. In support, note that the reference (para. [0041]) states that "the server provides a post office function", which implies that the server receives and retransmits some one message.
19. Rubstein et al. also teaches claims 15 (para. [0039 and 0043]) and 17 (para. [0040]).

Art Unit: 3622

20. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being obvious over Rubstein et al. Rubstein et al. does not teach that the information about the email user comprises the identity of a charitable organization designated to receive charitable contributions from operation of the system. Because charitable giving correlates with income and stock ownership, which reads on receiving proceeds from operation of the system, and because people can be well characterized by their choices in charitable giving, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Rubstein et al. that the information about the email user comprises the identity of a preferred charitable organization.

Allowable Subject Matter

21. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
22. Allowance is further dependent on successful vetting by a "second pair of eyes". Examiner has performed every search deemed reasonable, but does not ask for review of allowable subject matter until applicant indicates willingness to put the application in condition for allowance.
23. The following is an examiner's statement of reasons for the indication of allowable subject matter: the closest US patent prior art, Rubstein et al., does not teach or suggest parsing the subject and the body to identify keywords that may be present therein. Conley, Jr., et al. teaches searching email messages for keywords to target advertising (col. 2 line 67 to col. 3 line 2 and col. 1 lines 42-46), which reads on parsing the subject and the body to identify keywords that may be present therein. However, the prior art does not suggest the combination of Conley, Jr., et al. with Rubstein et al. The closest foreign patent and non-patent prior art respectively are WO 200079436A and Tweney. Both teach targeting advertising in email messages.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is

Art Unit: 3622

703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.

25. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

A handwritten signature in black ink, appearing to read 'DL Champagne', is written over a horizontal line.

18 September 2004